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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/798,035	03/11/2004	Chung Nin Danny Chan	244-5	5983
24336	7590	10/05/2004	EXAMINER	
KEUSEY, TUTUNJIAN & BITETTO, P.C.			FRANCIS, FAYE	
14 VANDERVENTER AVENUE, SUITE 128			ART UNIT	
PORT WASHINGTON, NY 11050			PAPER NUMBER	

3712

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/798,035

Applicant(s)

CHAN, CHUNG NIN DANNY

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's election with traverse of group II in Paper filed on 8/9/04 is acknowledged. The traversal is on the ground(s) that the present invention are directed to a common subject matter and the search and examination of the entire application can be made by the Examiner without serious burden. These arguments are not found persuasive because the applicant has failed to show that the search and examination of the entire application can be made without serious burden. The requirement is still deemed proper and is therefore made FINAL. Since all the pending claims read on the elected species (as the applicant appears to also agree with) all the pending claims are examined herein. Claims 10-20 are examined herein.

#### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching that the second member includes longitudinal grooves., as now recited in claim 16. No new matter should be entered into the application.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from the specification how longitudinal grooves can be incorporated into this device?

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 10: the phrase "at least one body part" is vague since only one body part may be encompassed therein [note the phrase "one or more body parts"]. It is not clear how many body parts being encompassed. Is it one body part or more than one?

With respect to claim 11: the phrase "a longitudinal axis of the second member and the longitudinal axis of the second member" is confusing. Note also claims 12 and 13 in similar regard.

Claim 14 recites the limitation "the joint" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10-11 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez Ferre.

Rodriguez Ferre discloses in Figs 1-10, a doll comprising an infrastructure which permits relative motion of the doll and an ability to pose portions of the doll, the infrastructure comprising: one body part including a first member [member 5 and part 8] having at least a portion of a ball [spherical bodies 8a], a second member [member 4] including a socket [semispheres 9], which receives the at least a portion of the ball, a protrusion [diametral appendix 8b] formed on the first member adjacent to the ball such that when the ball is received in the socket a rotation about a longitudinal axis of the first member is permitted while restricting an angular change between a longitudinal axis of the second member and the longitudinal axis of the second member. Additionally, Rodriguez Ferre discloses the protrusion extends about an entire circumference of the first member and prevents an angular change between a longitudinal axis of the second member and the longitudinal axis of the second member, the socket includes a slot [Fig 11] and the first and second members include longitudinal grooves [ribs 12 and 13].

9. Claims 10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenwood, Sr. et al, hereinafter Greenwood.

Greenwood discloses in Fig 1, an infrastructure which permits relative motion of the doll and an ability to pose portions of the doll, the infrastructure comprising: one body part including a first member [stem 24, ball 30 and wall 33] having at least a portion of a ball 30, a second member [grooved portion 25 and socket 23] including a

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socket 23, which receives the at least a portion of the ball, a protrusion [the curved part of the wall 33 connected to the stem 24] formed on the first member adjacent to the ball such that when the ball is received in the socket a rotation about a longitudinal axis of the first member is permitted while restricting an angular change between a longitudinal axis of the second member and the longitudinal axis of the second member.

Additionally, Greenwood discloses the protrusion extends about a portion of a circumference of the first member and prevents an angular change between a longitudinal axis of the second member and the longitudinal axis of the second member and the socket includes a slot [cut out portion 23B].

With respect to the doll, the device of Greenwood is presumed to be inherently capable of being made into a shape of a doll, in as much as the device of Greenwood is a construction system.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez Ferre in view of Wilcox et al, hereinafter Wilcox.

Rodriguez Ferre discloses most of the elements of these claims but for an outer covering and stuffing material for filling the outer covering.

Wilcox teaches the concept of providing a skeleton-like framework of a doll with an outer covering [integument 300] and stuffing material 380 for filling the outer covering to provide a natural appearance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provided the device of Rodriguez Ferre with the missing elements as taught by Wilcox in order to provide the device with natural feel and appearance making the device more fun to play with.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700